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10/577,407	04/02/2007	Danilo Molteni	1029.1033	1405
20311 7590 04/16/2008 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER				
MUSLEH, MOHAMAD A				
ART UNIT		PAPER NUMBER		
2832				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/577,407

**Applicant(s)**

MOLTENI, DANILO

**Examiner**

MOHAMAD A. MUSLEH

**Art Unit**

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04/26/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/ISD)  
Paper No(s)/Mail Date 04/26/2006  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Drawings***

1. **Figures 1-2** should be designated by a legend such as **--Prior Art--** because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **[10 and 11]** in **[figs. 5-6]** . Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

Art Unit: 2832

action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: the specification does not meet the requirements of 37 CFR 1.77(b), see the illustration below.

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### ***Arrangement of the Specification***

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING (S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. At [page 2, lines 23-24] the applicant recites that "fig. 3 is a cross-sectional view of a **prior art** pulley separator with ferrite and rare earth magnets according to the **present invention**", the recitation is not clearly discloses if [fig. 3] belongs to the prior art or to the present invention or it is just an improvement of the prior art.

Appropriate correction is required.

#### ***Claim Objections***

5. **Claims 4-5** are objected to under 37 CFR 1.75 (c) as being in improper forms because a multiple dependent claim should refer to other claims in the alternative only, and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

6. **Claims 4-5** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. **Claims 4-5** recite that "...separator according to **one or more of the preceding claims...**" that makes **claims 4-5** may depend on **claim 3**, so it is improper forms because a multiple dependent claim should refer to other claims in the alternative only, and cannot depend from any other multiple dependent claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1 and 3-5** are rejected under **35 U.S.C. 102(e)** as being anticipated by **Gleckner US 6,850,140 B1[Gleckner]**.
8. Regarding **claim 1**, at [figs. 1-5c] **Gleckner** teaches a ferromagnetic member [11] for the circuit connection between at least two magnetic poles [12/14], characterized in that each magnetic pole [12/14] is made up of ferrite magnets [12] in the bottom portion [fig. 2] in contact with the ferromagnetic member [11] for the circuit connection, and of rare earth magnets [14] in the top portion that represents the entrance/exit surface [fig. 2] of the magnetic flux lines [abstract].
9. Regarding **claim 3**, at [fig. 4] **Gleckner** teaches a ferromagnetic cylinder [26] around which there are applied the magnetic poles [12/14], the cylinder [26] being enclosed by a protective casing [30] of non-magnetic material [c. 6, l. 44-48] filled with a blocking resin [c. 5, l. 8-21], this assembly being secured onto a shaft [28] so that it can be used for a conveyor on which the material to be treated is drawn [c. 1, l. 20-29].
10. Regarding **claim 4**, the ferrite magnets [12] are made of barium ferrite or strontium ferrite [c. 4, l. 38-48].

Art Unit: 2832

11. Regarding **claim 5**, characterized in that the rare earth magnets are made of samarium-cobalt or iron-boron-neodymium [**c. 4, l. 49-57**].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claim 2** is rejected under **35 U.S.C. 103(a)** as being unpatentable over **Gleckner**.

13. Regarding **claim 2**, **Gleckner** discloses the claimed invention except for that in each magnetic pole **[12/14] the ratio** between the effective magnetic length of the ferrite magnets **[12]** and of the rare earth magnets **[14] is between 1:1 and 3:1**, being preferably 2:1. At **[c. 5, l. 54-64]** **Gleckner** discloses that "the ratio of the thickness of the layer of ferritic magnet to the rare earth magnet is preferably between 1:3 and 1:5, and even more preferably 1:3.". It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the ratio between 1:1 and 3:1, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **See the notice of references cited (PTO-892).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mohamad A. Musleh** whose telephone number is **(571) 272-9086**. The examiner can normally be reached on M-F (7:30-5:00 Est. Time) 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Elvin G. Enad** can be reached on **(571) 272-1990**. The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (**PAIR**) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (**EBC**) at **866-217-9197 (toll-free)**. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call **800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Elvin G Enad/  
Supervisory Patent Examiner, Art Unit 2832

/Mohamad A Musleh/  
Examiner, Art Unit 2832